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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,038	07/12/2001	Robert A. MacDonald	KEY1025US	1936

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EXAMINER

YIP, WINNIE S

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,038

Applicant(s)

MACDONALD ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is in response to applicant's amendment filed on February 6, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites the limitations "the first blocks" in line 7 and "the first and second blocks" in line 11. There is insufficient antecedent basis for this limitation in the claim and causes the claims infinite.

#### ***Claim Rejections - 35 USC § 102***

3. Claim 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bailey, II (US Patent No. 5,816,749).

Bailey shows and teaches a retaining wall comprising at least a first lower course (160) and a second upper course (161), each course comprising a plurality of blocks (10a', 10b', 10c'), each block (i.e. 10a', 10b', 10c') having a block body including spaced apart and parallel upper and lower surfaces (20, 22), the distance between the upper and lower surfaces defining a thinness of the block, opposed and substantially parallel first and second faces (12, 18), the first face (12) having an area greater than the second face (18), and opposed and non-parallel side

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surfaces (14, 16), the blocks have a same thickness, the lower surface (22) having two channels (38, 40) extended substantially parallel to the front and rear faces, the lower surface of the block (i.e., 210) may have a third channel (218) substantially parallel to the first front and second rear faces, the channels of the blocks are capably used to receive a horizontal reinforcement member as claimed, and the block may include a pin (i.e., 108 a-d) having a head portion (105c) and a body portion (106c), and a geogrid (110 a-b) is capably connected between the blocks in the upper and lower course. Wherein the blocks are placed in the courses such that the front surface of the wall is inherently formed from the first faces of the multiple blocks and the rear surface of the wall inherently formed by the second faces of the multiple blocks .

4. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Ciccarello (US Patent No.5,984,589).

Ciccarello shows and teaches a wall block (10) for forming a wall from multiple wall blocks and the wall having a front surface and a rear surface, the wall block (10) comprising a block body including spaced apart and parallel upper and lower surfaces (11, 12), the distance between the upper and lower surfaces defining a thinness of the block, opposed and substantially parallel first and second faces (13, 14), the first face (13) having an area greater than the second face (14), and opposed and non-parallel side surfaces (15, 16), one of the surface (11) having two channels (27) extending substantially parallel to the front and rear faces and transversely cross opposite side surfaces, and at least one of the front or rear surfaces is textured in a manner resulting in the appearance of nature stone, wherein the wall block is capable to be reversibly placed in the courses such that the block may have the lower surface formed with the channels

for receiving reinforcing rods as claimed, and the front surface of the wall is capably formed from the larger first faces of some of the multiple wall blocks and the smaller second faces of the other some multiple wall blocks as claimed.

***Claim Rejections - 35 USC § 103***

5. Claims 1-4, 7, 9-15, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. '460 in view of Bailey, II '749 and Kocher et al. (US Patent No. 3,418,774).

Miller et al. teach a retaining wall comprising upper and lower courses, each course comprising a plurality of blocks, each block having a block body including an upper and lower surfaces (28, 30) to define a block thickness, opposed and substantially parallel first and second faces (12, 22 and 24), the first face having an area greater than the second face, and opposed side surfaces (14, 16) are non-parallel to each other, the block having first and second channels (32, 52) formed on upper surface, and a third channel (102) formed on the lower surface, said channels (32, 52, 102) extending parallel to the first and second faces and transversely across the opposed side surfaces, the blocks having substantial same thickness, the block having at least one core (60) for receiving vertical reinforcing members passed therethrough, a geogrid (44) being secured to the first channel (32) of the blocks by a geogrid connector (70 or 120), the block further having a pin (50) having a body portion (56) sized to be fitted within a pin receiving aperture (54) formed on one of the upper and lower surfaces of the block and having a head portion (58) extending above the surface of the block of the lower course in a distance to be fitted into the core (60) of the block of upper course for retaining two vertically aligned blocks of upper and lower courses together, Although, Miller et al. does not define the first and second channels being located on the lower surface of the block and the pin aperture being located on

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the upper surface of the block as claimed, Bailey, II teaches a retaining wall comprising blocks each having two channels formed on the lower surface of the block for receiving a protrusion (24 or 26) extending from the upper surface of the block on the lower course, or receiving a geogrid connector (105a –105c) for securing a geogrid (110) between the blocks (see fig. 4). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the wall of Miller et al. having the blocks being reversibly positioned such that the block in the upper course having the lower surface formed with channels for receiving the protrusions such as the reinforcing rebars or the pin or the geogrid positioned on the upper surface of the block of the lower course as taught by Bailey, II as an common practice of one skill in the art to reversibly install the blocks for more easily positioning wall blocks vertically aligned and stacked one over another. Further, Miler et al. and Bailey, II do not define a wall having the blocks being positioned in the courses such that the front surface of the wall is formed by some first faces of the some of the wall blocks and the second faces of the other some of the wall blocks as claimed. Kocher et al. teach a wall comprising a plurality of wall blocks (20) each of the blocks having a first face (27) and a second face (23), the first face having an area greater than the second face, and the wall having a front surface formed by some first faces (27) of some wall blocks and some second faces (23) of other wall blocks as claimed. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the wall of Miller et al. combined Bailey, II having the blocks being reversibly positioned to provide the front surface of the wall form by some first faces of some of the block and some second faces of other some of the block as taught by Kocher et al. for providing a wall with desirable aesthetical appearance.

In regard to claim 2, although Miller et al. does not define the upper surface of the block does not having a third channel substantially parallel between the first and second channel, it is common engineering practice in construction of a wall block having more than two channels on one surface to allow to receive protrusions from the other block for adjustability of assembly. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in art to provide these features to the assembly of Miller et al.

6. Claims 1-14, 16- 33, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald (US Patent No. 6,149,352) in view of Khamis (US Patent No. 6,280,121).

MacDonald teaches a retaining wall comprising upper and lower courses, each course comprising a plurality of first, second , and third blocks (42, 44, 46) having different widths, each block having an upper and lower surfaces (8,10) to define a block thickness, opposed and substantially parallel first and second faces (12, 14), the first face having an area greater than the second face such that opposed side surfaces (16,18) are non-parallel to each other, the first or second faces being textured in a manner resulting in the appearance of nature stone, each block having at least one core (20) and apertures (22a-f) extending through the upper and lower surfaces of the block, the lower surface of the block having a channel (73), a pin (80) having a body portion (78) being fitted in one of the aperture on the upper surface of the block on the lower course and a head portion (76) extending upwardly and being inserted into the channel (73) on the lower surface of the block of upper course for retaining and stacking the blocks of upper course on the blocks of the lower course (see col.10, lines 57-62) , wherein the first and second blocks (42, 46) each having the two side surface being converged and the one of first and

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second faces (12) having an area greater than the area of other first and second faces (14), the third block having the first side surface (16) being substantially perpendicular to the first and second faces (12, 14) and the second side surface (18) being substantially non-perpendicular to the first and second faces, wherein the blocks being positioned in the courses such that the wall includes a straight section and a corner section oriented in a manner to form a 90 degree angle (see Fig. 2), and the front surface of the wall includes the first faces (the larger area) of some of the plurality of first or second blocks and the second faces (the smaller area) of the other plurality of first or second blocks. Although, MacDonald does not define the block having at least two channels extending passed through the lower surface and substantially or parallel to the first and second faces for receiving horizontal reinforcing members therethrough, Khamis teaches a retaining wall comprising a plurality of blocks (12), each block (12) having a plurality channels (46) formed on upper and lower surfaces for receiving a plurality of horizontal reinforcing members or a geogrid (16) placed thereover, and at least one core (42) extending vertically from the upper surface to the lower surface for receiving vertical reinforcing members (26) passed through. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the wall of MacDonald having blocks formed with at least two or three channels on the lower surface as taught by Khamis for receiving the horizontal reinforcing members or a geogrid placed thereover and a vertical reinforcing member passed therethrough the core as claimed for retaining and stacking the blocks one over another on the upper and lower course and preventing side movement of the blocks to stabilize and reinforce the wall .



7. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Correia et al. (US Patent No.5,528,873) in view of Scales '511.

Correia et al. show and teach a retaining wall inherently having front and rear faces, the wall comprising a plurality of courses of wall blocks, each wall block comprising substantially parallel upper and lower surfaces (33, 32) spaced apart to define a thickness of the block, opposed and substantially parallel first and second faces (35, 34), opposed side surfaces (9), the lower surface having at least two channels (16', 31'), a pin (20 or 40) disposed on the upper surface, the channel of lower surface of the block in an upper course functioning as a pin receiving cavity for receiving the pin extending from the upper surface of the block in the lower course for retaining and stacking the blocks one over the other. Correia does not define the first and second faces of the block having different size of area, such that the front surface of the wall is formed of the first faces of same multiple wall block and second faces of other multiple wall blocks. Scales teaches a wall comprising a plurality of first and second blocks (10, 12), each of the first and second blocks having opposed non-parallel side surfaces (22, 24), and opposed parallel first and second faces, wherein the first block (10) having the first face (20) having an area greater than the area of the second face (18), and the second block (12) having the first face (18) having an area greater than the area of the second face (20) such that the block is positioned that the front surface of the wall is formed of first face of some first block and second faces of other some second blocks. It would have been obvious to one of ordinary skill in the art to modify the wall of Correia et al. having the blocks having configuration with non-parallel opposed side faces and different sized opposed faces and being positioned as taught by Scales such that one of the channel of the upper block functioning as a pin receiving cavity for receiving

the pin of the lower block when the first face of the block forms the front surface of the wall, and the other channel functioning as an other pin receiving cavity for receiving the pin from the lower block when the second face of the block forms the front surface of the wall as an obvious matter of design choice for various applications.

***Response to Arguments***

8. In response to applicant's argument that, regard to the rejection to claim 13, Bailey, II '749 fail to teach the wall being formed of the first faces of a portion of the multiple wall block and the second faces of others of the multiple wall blocks as recited in claim 13, it is not deemed persuasive because, first anticipation is established when a single prior art reference discloses, expressly or under principles of inherence, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). In the case, Bailey, II teaches a wall block including all elements as claimed except does not define the block can be used to from a wall as claimed. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA

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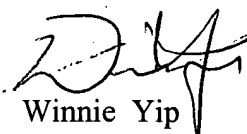
1963). In this case, application only positively recites a wall block but not a wall, Bailey clearly teaches a wall block having a configuration as claimed such as the wall block (10) includes a front face (12) and a rear face (18) with different areas as claimed. Therefore, the block of Bailey is considered to be capable to be reversibly positioned to form a wall having a front surface formed by the front face of some of the block of Bailey and the rear face of other block of Bailey as claimed.

Therefore, the rejection is deemed proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip  
Patent Examiner  
Art Unit 3637

wsy  
April 18, 2003